

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Ronald C. Schumann** Confirmation No.: **4760**
Serial No.: **10/679,966** Group Art Unit: **3753**
Filing Date: **October 06, 2003** Examiner: **Eric S. Keasel**
For: **Bi-Can Having Internal Bag**

Mail Stop Appeal-Brief Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPELLANT'S REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Appellants submit this Reply in response to the Examiner's Answer dated May 17, 2007 in connection with the above-identified application. This reply is being filed within two months of said answer.

1. STATUS OF CLAIMS

Claims 1 – 7 and 10 – 21 are under rejection; Claims 8 and 9 have been allowed; and claims 22 – 29 have been withdrawn. Claims 1 – 7 and 10 – 21 are appealed. Only independent claims 1 and 13 and dependent claim 16 will be argued in this Appeal.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1 and 16 have been rejected under Section 103 based on United States Patent Number 4,150,522 (Burger) in view of United States Patent Number 5,915,595 (Dow).

Claim 13 has been rejected under Section 102 based on Burger.

The final rejection states that Burger discloses all of the elements of claim 1 except Burger fails to disclose double seams, which are taught by Dow, and that the combination would be obvious. (Final Rejection, paragraph 7). The final rejection states that Burger discloses all of the limitations of claim 13. (Id., paragraph 5). And, in response to Applicant's argument, the final rejection states that "The seam of Burger is rolled. Please compare Burger, Fig. 2 to Applicant's figures. Burger seam is more rolled than Applicant despite use of the word crimped." (Id.)

2. ARGUMENT

Appellant maintains its arguments in its Appeal Brief. Comments to the Examiner's Answer below are grouped by the grounds for rejection; arguments for claims 1 and 16 (rejected based on obviousness) are provided first, followed by arguments for claim 13 (rejected based on anticipation).

Claim 1

The Examiner's Answer asserts that Appellant's argument ignores the rejection of record (that is, based on obviousness) and addresses the Burger reference piecemeal: "[t]he rejection has Burger, which discloses the thickened, bulbous end portion to be in the gap between the cap and body and not in the area in which the cap and body engage each other modified by the teachings of Dow et al., which disclose the cap and seam details (opposing sidewalls, arcuate portion therebetween, etc.)."

Appellant acknowledges that the rejection of claim 1 is based on obviousness; Appellant maintains its arguments in the Appeal Brief. For clarity, claim 1 requires a "cap seam portion including a pair of opposing sidewalls and an arcuate portion formed therebetween" and that the "body seam portion is at least partially disposed between the relatively opposing sidewalls of the cap seam portion," in addition to "thickened portion being disposed in the throat and spaced apart from the seam." This is entirely contrary to Burger, and Burger could not be modified in view of Dow to achieve the claimed structure.

Claim 16

Regarding claim 16, the Examiner's Answer asserts that Appellant speculates that a person of ordinary skill would, contrary to common sense, intend to tear the inner container when modifying Burger.

The above statement regarding the rejection of claim 16 aptly illustrates the disagreement at issue. Taking the Examiner's reasoning (for sake of argument) as a whole, Burger's "distal portion" forms the seam — apparently only the outermost portion of "crimped portion 20" and corresponding portion of "neck 16" — such that the thickened portion of the bag does not extend into the seam. But the rejection is silent on how Burger's "seam" (that is, a crimp) may be modified into a double seam as taught by Dow without crushing the thickened portion of the inner container, as the thickened portion is located in both the vertical portion and upper curved portion of space 24.

Rather, the straightforward application of the teachings of Dow to the structure of

Burger would tend to crush the thickened portion, contrary to a fundamental principle of Burger, as the portions of Burger forming space 24 would become part of the double seam structure. This is not Appellant's "speculation," but is the natural result of changing Burger's "seam" to a double seam.

Even if Burger could be modified according to Dow, contrary to one of its fundamental principles, the rejection does not explain how Burger could be fitted with a double seam such that the "thickened portion" of the inner container is "disposed in the throat and spaced apart from the [double] seam," as required by claim 16, without employing impermissible hindsight using the present application's own teaching.

Claim 13

The Examiner's Answer emphasizes that the rejection is based on anticipation, stating that "Burger anticipates claim 13 because the thickened portion of the inner container is in the throat (i.e. the gap between the cap and the body) in the same manner as Appellant's thickened portion is in the throat of the device." Further, the Examiner's Answer states: "The seam is the distal portion of the cap and body that engage each other and the thickened portion (18) of the inner container does not extend to the seam (see the gap shown in Burger, Fig. 2)."

Appellant relies on its Appeal Brief, including the statement that Burger "does not disclose the spaced apart relationship of the thickened portion of the inner container and the seam."

Further, because the term "rolled seam" of claim 13 connotes structure, the Examiner's Answer illustrates the internal inconsistency of the rejection. For example, the first paragraph of page 6 of the Examiner's Answer defines the seam as the distal portion of the cap and body that engage each other and, further, the thickened portion does not extend to the seam. Thus, Burger's "seam" is essentially entirely vertical, and can not itself be reasonably interpreted as a "rolled" seam, as required by claim 13.

For the above reasons and the reasons explained in the Appeal Brief, Appellant believes the claims are patentable.

Date: July 17, 2007

/Harold H. Fullmer/
Harold H. Fullmer
Registration No. 42,560

Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439